

### **REMARKS/ARGUMENTS**

This application has been reviewed in light of the Office Action mailed on December 7, 2006. Claims 1-23 are pending in the application with Claims 6 and 9-20 being previously withdrawn and Claims 1 and 21-23 being in independent form. Claim 22 has been amended by this response. In view of the amendments and remarks to follow, reconsideration and allowance of this application are respectfully requested.

#### **Claim Rejection – 35 U.S.C. §112**

In the Office Action, Claim 22 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In the interest of expediting prosecution, Applicants have amended Claim 22 to recite, “the offset distance X is in the range of about 0.005 inches to about 0.200 inches.” In Applicants’ disclosure, in the first full paragraph of page 15, it is stated that, “in accordance with the present disclosure, distance ‘X’ is from about 0.005 inches to about 0.200 inches.” Thus, Applicants’ disclosure complies with the enablement requirement with respect to Claim 22 and Applicants respectfully request withdrawal of this rejection.

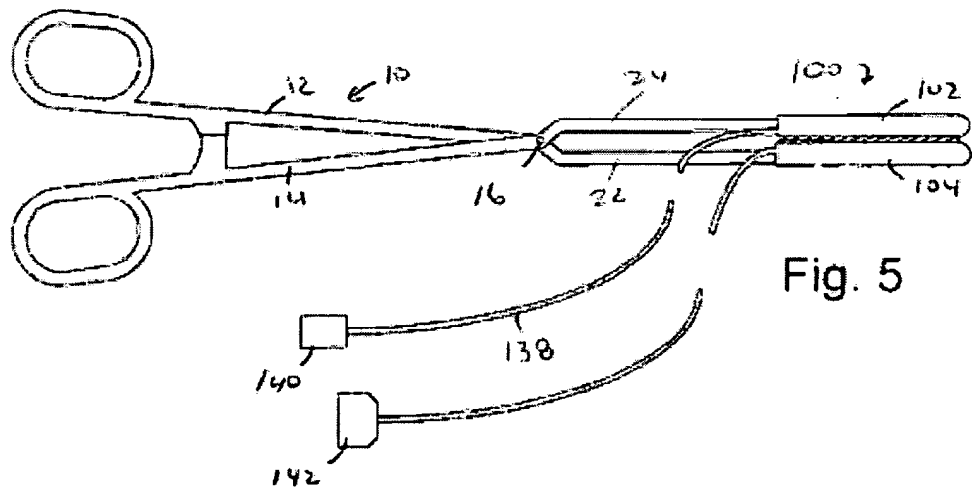
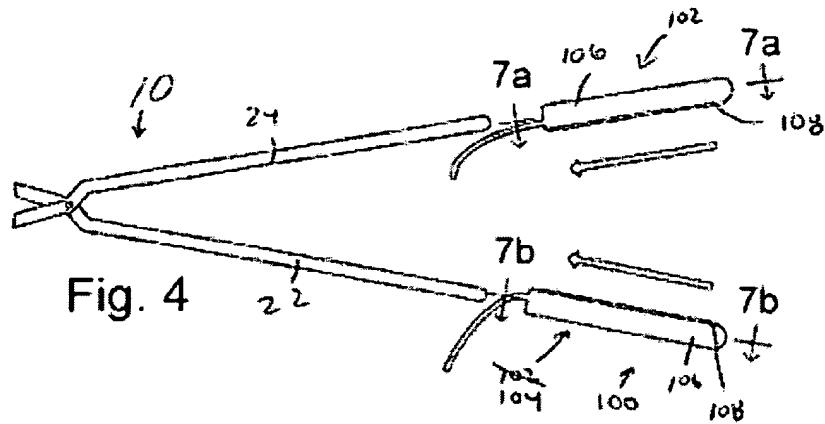
#### **Claim Rejection – 35 U.S.C. §103(a)**

Claims 1-5, 7-8 and 21-23 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,932,816 to Phan. Phan relates to an apparatus for converting a clamp into an electrophysiology device.

In the Office Action, it is asserted that Phan discloses a tissue or vessel sealing instrument, comprising, *inter alia*, first and second jaw members each “including an

elastomeric material 106 disposed on an inner facing tissue contacting surface thereof” and “each of the elastomeric materials including an electrode 108 disposed therein, the elastomeric material being adapted to compress or deflect about 0.001 inches to about 0.015 inches when the force used to close the jaw members is between about 40 psi to about 230 psi.”

Applicants' contend that Phan does not disclose such a tissue or vessel sealing instrument. More specifically, Phan does not disclose a tissue or vessel sealing instrument that includes an elastomeric material on an inner facing **tissue contacting** surface. In the Office Action, it is asserted that a base member 106 of Phan is an elastomeric material disposed on an inner facing tissue contacting surface. Contrastingly, Figures 4, 5, 7a, 7b and 8 of Phan, reproduced below, illustrate otherwise. As shown in these Figures, the base member 106 of Phan is outer-facing and is not disposed on a tissue-contacting surface. Rather, the energy transmission devices 108, which are inserted into slots 112 of the base member 106, are disposed on a tissue-contacting surface.





psi,” as claimed by Applicants. By contrast, each base member 106 of Phan includes “a longitudinally extending aperture 110 into which one of the clamp members 22 and 24 may be inserted. The apertures 100 should be sized and shaped such that the base members 106 will be forced to stretch when the clamp members 22 and 24 are inserted” (column 6, lines 37-42). Additionally, the base member 106 of Phan is adapted to “deflect when the energy transmission device 108 is inserted into the slot 112 and then snap back to hold the energy transmission device in place” (column 6, lines 61-64).

Thus, the base members 106, or “elastomeric material” of Phan, are disposed to **stretch** to enable insertion of the clamp members and are configured to deflect (and snap back) to hold an energy transmission device. No where does Phan disclose or even remotely suggest that the base members 106 are adapted to compress or deflect a particular distance upon application of a particular force to close the jaw members.

It shall be noted that Phan does disclose the use of deformable inserts 28 and 30 that may be used to “allow the clamp 10 to firmly grip a bodily structure 32 without damaging the bodily structure” (column 6, lines 6-10). However, in the embodiments where the clamp 10 is converted to be used as a bi-polar tissue coagulation device, these inserts 28 and 30 are removed and not included in the apparatus (column 6, lines 14-18; column 7, lines 1-4). The specific inclusion of the fact that deformable inserts 28 and 30 are **not used** in the tissue coagulation device, indicates that Phan teaches away from Applicants’ claimed disclosure. That is, the Phan disclosure shows that the inclusion of an “elastomeric material” (deformable inserts 28 and 30)

“disposed on an inner facing tissue contacting surface” of the jaw members (Figure 1) would only be suitable for a clamp and would not be suitable for a tissue coagulation device.

It is therefore clear that Phan does not disclose a tissue or vessel sealing instrument including, *inter alia*, an “elastomeric material being adapted to compress or deflect about 0.001 inches to about 0.015 inches when the force used to close the jaw members is between about 40 psi to about 230 psi,” as recited in independent Claims 1 and 21-23.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of this rejection and earnestly seek allowance of Claims 1-21-23, and Claims 2-5 and 7-8, which depend from Claim 1.

In the Office Action, it is further asserted that Phan lacks the electrodes being offset a distance X relative to one another, such that when the jaw members are closed about the tissue and when the electrodes are activated, electrosurgical energy flows through the tissue in a generally coplanar manner relative to the tissue contacting surface. It is then asserted that U.S. Patent No. 6,086,586 to Hooven discloses this feature and that it would have been obvious to combine Phan with the teachings of Hooven.

Notwithstanding the arguments above, Applicants also believe that the pending claims are allowable because of an improper combination between Phan and Hooven. Specifically, Applicants contend that there is no motivation to combine the references, and the rejection is thus improper in view of MPEP §2143.01, which provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The text of Phan supports Applicants' contention of an improper combination: "[t]he energy transmission assemblies in the exemplary embodiment are configured such that they will abut one another in the same manner as the inserts 28 and 30 (FIGS. 1-3) when the clamp 10 is in the closed orientation illustrated in FIG. 5." Thus, there is no motivation to combine Phan with Hooven to disclose a tissue or vessel sealing instrument having "electrodes being offset a distance X relative to one another such that when the jaw members are closed about the tissue and when the electrodes are activated, electrosurgical energy flows through the tissue in a generally coplanar manner relative to the tissue contacting surfaces." Thus, Applicants respectfully request withdrawal of this rejection and earnestly seek allowance of Claims 1 and 21-23, and Claims 2-5 and 7-8, which depend from Claim 1.

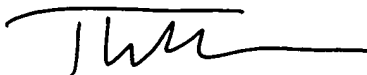
**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely Claims 1-5, 7-8 and 21-23, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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